AT-12857 IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Mark J. Kraffert	§	Group Art Unit: 2857
		§	
Serial No.:	09/776,364	§	
		§	Examiner: Jeffrey R. West
Filed:	February 2, 2001	§	
		§	
For:	Sharing Data Files in a Test Environment	§	Atty. Dkt. No.: MCT.0134US (MUEI-0558.00/US)

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P.O. Box 1450
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REPLY BRIEF

Sir:

This Reply Brief is in response to the Examiner's Answer dated August 3, 2005.

Replies to certain of the Examiner's arguments are presented below.

A. RESPONSE TO EXAMINER'S ARGUMENTS IN PARAGRAPH (11) OF THE EXAMINER'S ANSWER

GROUP 1 (CLAIMS 1 AND 2)

In the Appeal Brief, Appellant noted that the Examiner failed to establish a *prima facie* case of obviousness for at least the reason that there was no motivation or suggestion to combine the teachings of Slutz and Fujimori in the manner proposed by the Examiner. As conceded by the Examiner, Slutz does not teach identifying a file name of a first data file to use based on received plural parameters. However, the Examiner relied upon Fujimori as teaching the elements missing from Slutz.

As explained in the Appeal Brief, Slutz describes test programs that can be executed on clients. Each test program can read a corresponding configuration file to generate a desired set of database query language statements. On the other hand, Fujimori relates to an electronic musical instrument having a memory for storing musical tone information containing waveform data and assigning a file name to the file that stores the waveform data. Fujimori, Abstract. Fujimori has nothing to do with identifying a file name of a data file to use in *first and second tests* based on plural parameters. All Fujimori would have suggested to a person of ordinary skill is a technique for assigning a file name for storing musical tone information. Such a person of ordinary skill in the art would not have been motivated by the teachings of Fujimori to identify a file name of a data file to use, by first and second test systems in each of first and second tests, based on plural parameters. Fujimori merely teaches to a person of ordinary skill in the art that the file name of musical data can be found by combining two different character strings.

As consistently warned by the Federal Circuit, obviousness cannot be established by combining teachings of prior art references to produce the claimed invention absent some teaching or suggestion to support the combination. *See In re Fritch,* 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). "Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* A person of ordinary skill in the art looking to the disparate teachings of Slutz and Fujimori would not have been motivated to combine the references.

In the Examiner's Answer, the Examiner cited *In re Oetiker,* 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992) as supporting the obviousness rejection based on the asserted combination of Slutz and Fujimori. Examiner's Answer at 18. *In re Oetiker* clearly does not support the Examiner's position. *In re Oetiker* expressly held that there "must be some

reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of invention would make the combination." *In re Oetiker*, 977 F.2d at 1446. "The combination of elements from nonanalogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness." *Id.* In *In re Oetiker*, the court held that the PTO Board failed to establish that a person of ordinary skill in the art would seek to solve a problem of fastening a *hose* clamp with fasteners for *garments. Id.* Analogously, the Examiner in this case has failed to establish that a person of ordinary skill in the art looking to perform first and second tests in first and second test systems would look to a reference (Fujimori) that relates to assigning file names for storing musical information.

The only basis for the combination of Slutz and Fujimori is impermissible hindsight. "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Because no motivation or suggestion existed to combine the teachings of Slutz and Fujimori, the Examiner has clearly failed to establish a *prima facie* case of obviousness.

Moreover, as explained in the Appeal Brief, the Examiner has also mischaracterized the teachings of Slutz in rejecting claim 1 over the asserted combination of Slutz and Fujimori. Slutz fails to disclose or suggest at least the following element of claim 1: the first and second test systems using *the first* data file in performing respective first and second tests.

As noted in the Appeal Brief, the teachings of Slutz require that different configuration files have to be used to perform different tests. The configuration file 400 described in Slutz specifies the name of a database 260. Slutz, 5:33-35. This testing process of Slutz is not limited

to one or more fixed databases for testing a database system, but rather can employ arbitrary, user-selected target databases. Slutz, 5:35-37. To select different databases, different configuration files (containing different references to databases) would have to be used. As further noted by Slutz, "particular features and statement characteristics that produce problems can be emphasized merely by changing a few parameters in the file." Slutz, 8:8-11. This is an indication that the parameters of the configuration file 400 are changed for different tests, which indicates that different configuration files are used. Therefore, in view of the foregoing, it is respectfully submitted that the hypothetical combination of Slutz and Fujimori does not teach or suggest each and every element of claim 1, even assuming that there existed a motivation or suggestion to combine the teachings of Slutz and Fujimori.

For the foregoing additional reasons, reversal of the final rejection of the above claims is respectfully requested.

CLAIM 5

As noted in the Appeal Brief, the character strings FNB1 and FNB2 taught by Fujimori do not represent a database, as recited in claim 5. Therefore, the hypothetical combination of Slutz and Fujimori would not teach or suggest identifying a file name of a first data file to use in each of the first and second tests based on plural parameters (where one of the parameters represents a database). Such parameters are clearly not taught by Slutz, nor are they taught by Fujimori. Therefore, the hypothetical combination of Slutz and Fujimori cannot satisfy the subject matter of claim 5. This point was conceded by the Examiner in the Examiner's Answer. Examiner's Answer at 19 ("The examiner maintains that the features of claim 5 are not met by the inventions of Slutz or Fujimori *individually*, but instead are met by the combination of Slutz and Fujimori") (emphasis added). Appellant agrees with the Examiner that the features of claim

5 are not taught by either Slutz or Fujimori – however, Appellant does not agree that the combination of Slutz and Fujimori somehow teaches or suggests an element that is taught in neither reference.

For the foregoing additional reasons, reversal of the final rejection of claim 5 is respectfully requested.

GROUP 5 (CLAIMS 23, 24, AND 32)

With respect to the claims of Group 5, the Examiner continues to engage in piecemeal identification of unrelated elements of prior art references to combine elements to achieve the claimed subject matter. As noted in the Appeal Brief, Talley does not disclose searching a predetermined directory on a device to find a *test* file containing a string that is concatenated from received first and second parameters. Talley describes operations that look for a *configuration file* and determines if the configuration file exists in the user's home directory. Talley, 6:18-23. However, looking for the configuration file of Talley is not the same as searching a directory to find a *test* file, as recited in the claims.

The Examiner argued that "Talley's teaching of searching predetermined storage locations and directories for finding and retrieving the configuration file ... does teach searching a predetermined directory to find a test file." Examiner's Answer at 24. This characterization of Talley is clearly erroneous, as the word "test" is nowhere found in Talley. Therefore, in view of the foregoing additional reasons, the final rejection of the above claims is respectfully requested.

GROUP 7 (CLAIMS 1-5, AND 28-32)

As argued in the Appeal Brief, nowhere within the teaching of Gartner is there any indication of *first and second test systems* that (1) receive plural parameters, (2) identify a file name of a first data file to use in the first and second tests, and (3) use the first data file in

performing the respective first and second tests. Gartner discloses retrieving an external file reference from a table stored in a database system, with the file name identifying a file in an external file system. The identified file is retrieved from the external file system and used to test the database system. Gartner, 3:5-20.

The Examiner continues to argue that Gartner teaches first and second test systems performing the various tasks based on the fact that Gartner discloses that a plurality of users can access the file system and database system. *See* Examiner's Answer at 27 (citing column 3, lines 1-2, and column 4, lines 21-23, and 54-59 of Gartner). The plurality of users of Gartner clearly do not *receive* plural parameters, do not *identify* a file name of a first data file to use in first and second tests based on plural parameters, and do not use the first data file in performing respective first and second tests. Therefore, the assertion that the hypothetical combination of Gartner and Fitting teaches or suggests all elements of the claim is erroneous.

Moreover, with respect to Appellant's argument that there existed no motivation or suggestion to combine Gartner and Fitting, the Examiner continues to use impermissible hindsight to piece together unrelated elements of Gartner and Fitting to achieve the claimed invention. Examiner's Answer at 29. Gartner relates to a testing method and apparatus for evaluating performance of a database system that includes external file references, whereas Fitting describes a quality control system that uses bi-directional messaging that includes empty files. As noted by *In re Oetiker,* case law relied upon by the Examiner, if the only basis for combining the unrelated references, Gartner and Fitting, is impermissible hindsight, then such combination is improper. Therefore, a *prima facie* case of obviousness has not been established with respect to the above claims.

GROUP 8 (CLAIMS 6-14, 17-19, 23, 24, AND 27)

In the Examiner's Answer, the Examiner continues to ignore the fact that Gartner does not disclose or suggest receiving a second value representing a database to perform a test on, where the second value is combined with a first value to generate a file name of a test file to use in the test. Although the cited passage of Gartner made in the Examiner's Answer (Gartner, 2:39-40) refers to the random testing of external file references, that does not change the fact that Gartner teaches that the database system being tested is DBMS 15. The external file reference refers to test files – they are not the databases being tested.

Since neither Gartner nor Fitting teaches or suggests the claimed invention, the hypothetical combination of these references does not teach or suggest all elements of claim 6. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 6, and the other claims in this group.

B.   CONCLUSION

In view of the foregoing arguments and the arguments presented in the Appeal Brief, reversal of all final rejections is respectfully requested.

Respectfully submitted,

Date:_____

Dan C. Hu
Registration No. 40,025
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, TX 77024
Telephone: (713) 468-8880
Facsimile: (713) 468-8883